

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28
29
30
31
32
33
34
35
36
37
38

RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OPHIR FRIEDER and ABDUR R. CHOWDHURY

Appeal 2007-1954
Application 09/629,175
Technology Center 2100

Oral Hearing Held: October 24, 2007

Before MICHAEL R. FLEMING; *Chief, Administrative Patent Judge*,
and HOWARD B. BLANKENSHIP, ALLEN R. MacDONALD,
JAY P. LUCAS, and ST. JOHN COURTENAY, III, *Administrative Patent*
Judges.

ON BEHALF OF THE APPELLANTS:

MARK J. HENRY, ESQUIRE
Staas & Halsey, L.L.P.
1201 New York Avenue, N.W.
Suite 700
Washington, D.C. 20005

The above-entitled matter came on for hearing on Wednesday,
October 24, 2007, commencing at 2:00 p.m., at the U.S. Patent and
Trademark Office, 600 Dulany Street, Alexandria, Virginia, before
Dawn A. Brown, Notary Registration No. 7066896, Notary Public.

1 P R O C E E D I N G S

2 THE CLERK: This is Calendar Number 29, 2007-1954. And the
3attorney is Mr. Mark Henry.

4 MR. HENRY: Good afternoon. My blood pressure would have been
5just fine with three of you, but thanks for being here.

6 JUDGE FLEMING: You can proceed when ready.

7 MR. HENRY: I think, mainly, the brief speaks for itself. I think it is
8a claim interpretation issue. I think that the MPEP standard is the broadest
9reasonable interpretation for claim language, and I think we've exceeded. I
10think the interpretation given by the examiners is well beyond the broadest
11reasonable interpretation. I could go into --

12 JUDGE FLEMING: Do you believe you argued all the claims or just
13two of the claims?

14 MR. HENRY: Primarily, I think if you look at the prosecution history
15--

16 JUDGE FLEMING: That does not count. What we need to know is,
17what did you argue in your brief?

18 MR. HENRY: We argued all the claims.

19 JUDGE MacDONALD: I think we mean in terms of the argument
20presented, were the claims grouped as Independent Claim 1 and all its
21dependent claims and then Independent Claim 50 with 51. We couldn't
22quite tell from the brief what you intended.

23 MR. HENRY: All right. The claims -- Independent Claim 1 is
24certainly different from the Independent Claims 50 and 51. So these were
25argued separately.

1 JUDGE FLEMING: Okay. All right. So then wouldn't you agree
2then that Independent Claim 1 is in alternative language?

3 MR. HENRY: I would agree.

4 JUDGE FLEMING: Independent Claim 1 as to the issue is broader.

5 MR. HENRY: I would agree. Ignoring the other limitations in
6Independent Claim 1, but that one feature the prosecution has concentrated
7on, it is my opinion that Independent Claim 1 is broader than the other
8independent claims.

9 If we're just talking about tokens being eliminated based on at least
10one of parts of speech in collection statistics, that is in Claim 1; whereas, in
11claims 50 and 51, it just says to eliminate tokens based on parts of speech. It
12doesn't give the collection statistics.

13 JUDGE MacDONALD: For the record, this is the filtering step.

14 MR. HENRY: I do agree with you on that point. The reference
15doesn't just simply have it.

16 JUDGE FLEMING: Doesn't have what?

17 MR. HENRY: Filtering based on parts of speech. And it also doesn't
18have the collection statistics filtering.

19 JUDGE MacDONALD: On the second one, could you explain that a
20little further because you pointed to the language the examiner referenced,
21which is -- I believe it is Column 8 -- sorry. Column 9 in the reference
22where the examiner pointed to frequency -- words used frequently. And
23how is that different from statistics related to the number of recurrences of
24words?

11Appeal 2007-1954
12Application 09/629,175
13

1 MR. HENRY: Well, used frequently, we define collection statistics in
2our application as relating to a collection of documents. It is described
3beginning at page -- the first substantive page of the application at line 3, so
4we're talking about the number of occurrences in a document, not the
5number of occurrences in everyday language.

6 So, for example, the one we mentioned in our appeal brief, 35 U.S.C.,
7certainly would not be a frequently occurring word or group of letters in
8everyday use. But if we are filtering appeal briefs, if we have a bunch of
9appeal briefs and we're filtering them to see if we have any similarity, then
10we would -- that collection, then it would be --

11 JUDGE MacDONALD: You're talking about a differentiation based
12on the references dealing with the universe and you're dealing with a specific
13subset of the universe?

14 MR. HENRY: Exactly right.

15 JUDGE MacDONALD: So that leads me to the next question. Why
16would doing this function on a subset be unobvious given it is known to do
17it based on a known universe?

18 MR. HENRY: Well, I don't think that was envisioned in the Aiken
19reference. I don't think Aiken was really looking at --

20 JUDGE FLEMING: The question is whether Aiken suggests to --

21 MR. HENRY: I think Aiken is concerned with -- it is not concerned
22with comparing document collections; therefore, there is no suggestion in
23Aiken to look at a document collection. I mean, I don't think the --

1 JUDGE MacDONALD: I thought the point of Aiken was to compare
2 documents -- it is a small collection, but I thought it was still a collection.
3 And, in fact, I think that would be the case even if you had two documents
4 being compared together where one is the collection and one is the
5 document to be compared to.

6 I don't see that kind of differentiation based on the size of the
7 collection in the claim that shows it has to be a certain size.

8 MR. HENRY: I would agree that two is a collection. That is
9 certainly reasonable.

10 These arguments were not raised by the examiner during --

11 JUDGE FLEMING: You have any other points you want us to
12 consider as far as this one rejection?

13 MR. HENRY: As far as the collection statistics?

14 JUDGE FLEMING: As far as the 103 rejection.

15 MR. HENRY: I think if there is any questions about filtering based
16 on parts of speech. I don't want to be too argumentative, but if there is any
17 questions about that --

18 JUDGE FLEMING: Not for me.

19 Any of the other judges?

20 MR. HENRY: All right.

21 JUDGE FLEMING: May I move on to another topic?

22 MR. HENRY: Yes.

23 JUDGE FLEMING: Are you familiar with the recent decision by the
24 Federal Circuit in *In re Comiskey*?

1 MR. HENRY: I've heard of that, yes, but I'm not -- perhaps you can
2help me.

3 JUDGE FLEMING: Our concern is Claim 1 in particular is not -- I'm
4wondering if it meets the standard of being a process within the meaning of
535 U.S.C. 101.

6 The Federal Circuit has given us some recent guidance in that for it to
7be a proper statutory process, you need to either have a transformation or
8that the process involves the statutory classes. And we were wondering
9what say there because we're at a loss at finding out about documents --

10 MR. HENRY: I'm sorry. Documents, certainly is a concrete item.

11 JUDGE FLEMING: Is a document -- your definition of a document
12could be a word by your own spec?

13 MR. HENRY: Yes.

14 JUDGE FLEMING: So that certainly is an abstraction. Certainly
15doesn't -- I can give you -- this pretty much reads our normal steps.
16Obtaining a word, filtering a word -- I can do that by minimal steps. I don't
17see that we're involving the statutory process.

18 MR. HENRY: Do you think it needs to recite some sort of output
19step?

20 JUDGE FLEMING: I'm looking at the claim. I don't draft them, you
21do.

22 JUDGE COURTENAY: There is nothing in your claim that ties it to
23a machine.

24 JUDGE FLEMING: Or directed to any other statutory process.

25 MR. HENRY: So a computer-readable medium would certainly.

1 JUDGE FLEMING: We're worried about that as well, but we'll get to
2that.

3 JUDGE MacDONALD: For other reasons.

4 JUDGE FLEMING: Did you have any thoughts? Obviously, we're
5contemplating -- we thought we would give you an opportunity before we
6started exploring these contours.

7 MR. HENRY: The document-storage structure, I mean, that --

8 JUDGE COURTENAY: Is that a data structure? Is that some sort of
9data -- storage data structure?

10 JUDGE MacDONALD: I think in the specification you specifically
11give examples of what a document storage structure can be. Let me put my
12hand on it. Actually, Mike, there is another spot -- Judge Fleming -- where
13there are specific examples given that include a binary tree and others, which
14are data structures.

15 JUDGE LUCAS: That is on page 16, bottom paragraph.

16 JUDGE FLEMING: 16?

17 JUDGE MacDONALD: Yes, here. I think the discussion starts a
18little further up. The document storage structure comprises any data
19structure that is efficient for storing and accessing representations. And then
20the examples, see Number 1 for, actually, a quite lengthy list of examples.

21 So looking through the different features and going by the specific
22definitions in the spec and examples, I didn't see any machine structure in
23the claim.

1 MR. HENRY: All right. Do you think -- I don't know if it is
2appropriate to ask your opinion. Could the document-storage structure be
3revised so that it is a concrete physical entity?

4 JUDGE FLEMING: We don't know.

5 MR. HENRY: It is storing --

6 JUDGE LUCAS: There are a number of tools that would be available
7to your. What we're looking at, however --

8 MR. HENRY: -- is what is there right now to see if you need to raise
9it.

10 JUDGE FLEMING: The other problem is your defense simply says
11that you put that abstraction.

12 JUDGE MacDONALD: 27 and 28.

13 JUDGE FLEMING: Claim 27, which is the computer performing the
14method of 21. This would be a different line of reasoning not under
1535 U.S.C. 101 because you are claiming a machine. But our concern,
16though, is the guidance from the Federal Circuit, again, in Comiskey and
17Leap Frog of the question of 103.

18 MR. HENRY: 103 because it is arguably a different statutory class of
19subject matter or 103 because Claim 1 -- you feel Claim 1 is a 103 issue?

20 JUDGE FLEMING: The question would be is just simply putting an
21abstraction on a computer is that -- and you have solved nothing more than
22that -- is that enough for 103? At least, does it establish likely to be obvious
23where you could obviously show that to overcome that?

1 JUDGE LUCAS: There are certain presumptions. If we presume that
2we have problems with Claim 1 as an abstraction, then a computer for doing
3it, is that sufficient to draw it out?

4 MR. HENRY: I see. So in other words, if Claim 1 has an issue with
5eliminating based -- eliminating tokens based on collection statistics, that
6language -- if that creates a problem, then you're saying that problem may
7want be cured by the recitation?

8 JUDGE FLEMING: We're not sure. We're just simply raising this
9because in *In re Comiskey*, they're remanding that question to us with the
10very same claim structure. They have found the independent claim
11nonstatutory and they're asking us to consider a dependent claim, which is
12similar to yours, which is just simply claiming a computer comprises that
13method as being one under 103.

14 And what the statement is, is that they don't see how simply placing
15an abstraction on a computer is not --

16 MR. HENRY: Right. I would think if Claim 1 -- this is a
17hypothetical claim so you can shut me up when you want to. If Claim 1 said
18a computer for -- to perform a method and then did not include the
19collection-statistics language, I would think there would be no issue at all.
20Is that --

21 JUDGE FLEMING: Again, we're not going to go there. We're just
22trying -- with that question, I guess you're conceding you might see the
23Claim 1 might have this problem.

1 MR. HENRY: I'm not conceding. I think we could make the
2argument for the document-storage structure. I mean, if you need to store
3something, it is hard to do that in an abstract, you know -- to store a
4document.

5 JUDGE COURTENAY: The data structures are just mere
6abstractions. They're arrangements of data. As you have disclosed in your
7specifications, it is not a storage element or piece of hardware per se.

8 JUDGE LUCAS: It doesn't say a hard drive. It is just a data
9structure.

10 JUDGE FLEMING: For the record, we've seen a lot of yes nods.

11 MR. HENRY: How about if I --

12 JUDGE FLEMING: A lot of no-ing nods now. Well, you know, this
13would be a 41.50(b) [rejection] if we chose to go down that route. And,
14obviously, you would have a response as to whether or not you want to
15reopen prosecution and proceed with that.

16 JUDGE MacDONALD: All right. Before we're done on this
17particular claim, I'd like to mention two other cases that were applied to
18other claims that you might also want to take a look at. Nuijten, N-U-I-J-T-
19E-N, which deals with signal claims.

20 And this came about because your Claim 28 cites computer-readable
21medium, and in your specification, you say it is a carrier wave at page 10.

22 MR. HENRY: Right. So the storage would be --

23 JUDGE MacDONALD: Well, computer storage is usually limited,
24but it depends on how you would define computer-readable medium. You

1used a definition and explicitly stated it includes carrier waves, and the court
2has ruled on that recently.

3 The other issue you might want to take a look at is with respect to -- at
4Claim 51, [we] couldn't quite discern whether that was intended to be a
5means plus function claim or not. But the original application -- we have
6element claims, like[wise] we can't find any elements that correspond to this
7in the specification for the elements of Claim 51. It is not clear whether this
8is a new matter.

9 If it is intended to be a means plus function claim as original, you
10know, cancelled Claim 29, then what are the means? Because your brief
11didn't treat this as a means plus function claim, and we're struggling to find
12the structure because there is only one drawing of a computer, which is a
13box.

14 There is your method functions described, and there is a single-line
15code to implement each step or each device.

16 So we're not -- it is not clear if there is a problem similar to -- look at
17Biomedino, 112(2nd), problem for means plus function claim where it is not
18clear what structure is actually intended to be covered. That decision is
19from, I think, June of this year.

20 Do any of you happen to know the name -- there was a more recent
21decision where they reversed the lower court and said it was sufficient. St.
22John, I believe, you were.

23 JUDGE COURTENAY: AllVoice.

24 JUDGE MacDONALD: AllVoice Computing versus Nuance
25Communications. That should give you the boundaries of what they said on

51Appeal 2007-1954
52Application 09/629,175
53

1this issue. When they said there was a problem, one said there was, one said
2there was not.

3 MR. HENRY: All right.

4 JUDGE FLEMING: Anything else you want to leave us with?

5 MR. HENRY: No.

6 (Whereupon, the proceedings at 2:22 p.m. were concluded.)

7

8